

Attorney Docket No.: 5686.200-US
Express Mail Label No.: EV 246880709 US
Application No.: 09/483,504
Filed: January 14, 2000
Inventors: Teng et al.

Remarks/Arguments

Reconsideration and allowance are respectfully requested. Claims 1, 37, 52-53 and 65-87 are pending and are at issue following entry of this Amendment. Claim 1 has been amended for a second time to clarify the number and nature of the heteroatoms in the R9 heteroaryl moiety and to overcome the cited prior art. Added claims 71-78 depend from previously presented claim 37 and added claims 79-87 are directed to specific compounds from the Examples that fall within the elected invention. The amendments to the claims presented herein therefore do not add new matter and will not require any further search by the Examiner. Accordingly, the Examiner is requested to enter these amendments.

Rejections under 35 U.S.C. §112 second paragraph

Claims 1, 37, 52-53, and 65-70 are rejected under 35 U.S.C. §112, second paragraph as being indefinite on the following grounds:

- A) over the recitation of R9 (the variable M in claim 1 can be NR9-CH2-) as a heteroaryl because the claims are silent about the number and nature of the heteroatoms in the ring and their exact point of connection with the N of the bridge when present; and
- B) claim 65, for not being limited to a single disease or disorder; the Examiner stating that the claim should be limited to the specific diseases as per the tests conducted on page 166 of the specification.

These rejections are respectfully traversed and each rejection is addressed below:

- A) claim 1 has been amended to recite the number and nature of the heteroatoms that may be in the heteroaryl ring and Applicants submit that the ring may be connected to the bridging nitrogen at any ring atom that would permit such a connection.

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B) claim 65 as written has a clear and definite meaning to one of ordinary skill in the art. Under section 112, second paragraph, the breadth of a claim is not to be equated with indefiniteness. Rather, all that is required by section 112, second paragraph is that one of ordinary skill in the art reading the claims would understand the nature of the language recited in the claim in light of the specification. Here, claim 65 is directed to a method for the treatment of disorders or diseases wherein an activation of the human GLP-1 receptor is beneficial and the specification clearly discloses on page 41, lines 6-17 disorders and diseases where activation of the GLP-1 receptor is beneficial. Thus, the language of claim 65 is in compliance with the requirements of section 112, second paragraph and should not be limited to a single disease or disorder.

For the foregoing reasons, Applicants submit that the above amendments and remarks address the rejections of the claims under 35 U.S.C. §112, second paragraph and withdrawal of these rejections is therefore respectfully requested.

Rejections under 35 U.S.C. §102 (b)

Claims 1, 37, 52-53 and 65-70 are rejected under 102 (b) as being anticipated by Bata et al WO 97/19934, Sam et al US patent No. 4,022,777, Wozniak et al [Indian J. of Heterocyclic Chemistry (1994) 42:75-80] and Kyowa et al JP 55127205 and the Chemical Abstract reference numbers cited on pages 4-5 of the Office Action as attributable to these references. Applicants respectfully traverse this rejection as follows¹:

First, it is believed that with respect to claim 1 and claims 52-53 and 67-68 dependent therefrom, the amendment to claim 1 to delete that L can be “-S-, -SH, -NH₂ or -NH-”, renders this rejection moot.

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Second, with respect to claim 37 (and claims 71-74 dependent therefrom) where R¹ and R⁴ are fixed as hydrogen and R² and R³ are fixed as chlorine, it is believed that the rewriting of this claim as an independent claim where L can be -SO₂-CH₂-, -S-, or -SH but not -NH₂ or -NH- renders this rejection moot.

Third, it is believed that no amendment to the compounds used in the methods of claims 65 and 75 (these claims recite the compounds of claims 1 and 37 respectfully as they were written prior to the present Amendment) is necessary since the prior art compounds cited by the Examiner are chemical intermediates and not final products and the four prior art references cited under the 102 rejection do not teach the use of the compounds described therein for the treatment of disorders or diseases wherein an activation of the human GLP-1 receptor is beneficial [WO 97/19934 discloses that its compounds show significant activity at the glycine binding site of the NDMA receptor (page 1, lines 26-270), USP 4,022,777 as useful as fungicides (see col. 1, lines 12-13), JP 55167205 as useful as herbicides; and Wozniak says nothing about the utility of the compounds described therein]. Finally, Applicants submit that claims 79-87, directed to specific examples in the application, are free of the cited art.

1. Applicants acknowledge the Examiner's reference to the CASRN #s listed on page 2 of the Office Action and while the Examiner has not applied these as part of the formal 102 (b) rejection, Applicants have, in the interests of furthering prosecution, also addressed these CASRN#s in responding to this Office Action

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Accordingly, in view of the above amendments and remarks, withdrawal of this rejection is respectfully requested.

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

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Richard W. Bork
Richard W. Bork, Reg. No. 36,459
Novo Nordisk, Inc.
100 College Road West
Princeton, NJ 08540
(609) 987-5800

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